

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Buell, Andrew Pratt	Examiner:	Lee, John W.
Serial No.	10/766,700	Group Art Unit:	2624
Filed:	January 28, 2004	Docket No.	092807-011500
Customer No.:	33717	Confirmation No.:	8931
Title:	MOTION PICTURE ASSET ARCHIVE HAVING REDUCED PHYSICAL VOLUME AND METHOD		

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Name: Angela Williams

**LETTER SUBMITTING REMARKS WITH
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

MAIL STOP: AF
Commissioner for Patents
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Dear Sir/Madam:

This paper is being filed with a Pre-Appeal Brief Request For Review and a Notice of Appeal. Applicants seek formal review by a panel of Examiners of the rejections of claims 27-38 in the Final Office Action dated July 11, 2008. The Examiner has maintained these rejections in an Advisory Action dated December 2, 2008.

§ 112 Rejections

Applicants note that claim 37 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite based on the phrase "such that" previously recited in this claim. Applicants removed the phrase "such that" in the claim amendments filed on March 13, 2008. The Examiner recognized on page 2 of the Final Office Action that such claim amendments overcame the previous § 112 rejections; however, the Examiner mistakenly repeated the § 112 rejections on page

4 of the Final Office Action. The Examiner recognized this error during a telephonic interview but confusingly has refused to recognize and correct this error in the Advisory Action.

§ 101 Rejections

Claims 27-37 were rejected under § 101 as being directed to non-statutory subject matter. It is asserted in the Office Action that such claims are drawn to functional descriptive material that is not claimed as residing on a computer readable medium. However, claims 27-37 are not merely directed to functional descriptive material, but are rather directed to a new and useful machine or manufacture in accordance with statutory eligible subject matter defined in 35 U.S.C. § 101. Claims 27-37 are directed to a reduced motion picture storage device comprising “a roll formed by winding the plurality of media segments, each segment spliced to another of the segments.” Thus, claims 27-37 are directed to an actual physical roll of motion picture media segments that are spliced together. FIGURE 2 of the present application clearly illustrates the physical real world application of the roll of motion picture media segments that are spliced together. Mere use of the word “archive” in the preamble does not render the subject matter non-statutory.

Claims 27-37 are in fact directed to patent eligible subject matter under 35 U.S.C. § 101 in view of the fact that these claims are directed to a statutory class of “manufacture” under § 101 and were not simply a “collection of paper” as further recited in paragraph 2 of the Office Action. The Examiner indicated during a telephonic interview that claim 38 was directed to patent eligible subject matter because it was directed to a “real world physical product,” but the Examiner appeared to indicate that claim 27 did not require the same. Applicants reiterate that claim 27 does require such a real world physical product in reciting “a wound roll of a plurality of spliced together motion picture media segments” and further recites “a database” having a record for each segment containing locations of each segment within said roll. Applicants further note that the USPTO has previously found other types of “motion picture archives” to be directed to statutory subject matter, such as in U.S. Patent No. 7,298,451 (e.g., claims 17+).

§ 102 & 103 Rejections Based Primarily on *Reber*

Independent claim 27 is directed to an archive of a plurality of media segments that are **spliced together and wound to form a roll.** Independent claim 38 is directed to a storage device

for reducing the physical storage volume of a plurality of physical media segments from a motion picture that includes a wound roll of the plurality of physical media segments. Further, each media segment includes a location within the roll that is stored in a database to associate the media segment with its associated location so that it can be easily located on the roll and accessed. The roll of media segments further reduces the physical storage volume required of the media segments.

Reber Fails to Disclose a Roll of Spliced Together Media Assets

Rather than archiving media segments on a wound roll, *Reber* is directed to created a digital archive by “linking or binding a digitized representation of the media” with a specific reference to the media. *See Summary of the Invention, col. 2, lines 45-47.* *Reber* describes that:

“Digitized media data from the capture system is transferred and stored on a mass volume storage volume such as a hard disk drive as digitized media files and selectively retrieved under the control of a media storage and retrieval system which is the subject of the present application.” (col. 3, lines 50-55)

Even the cited portion of *Reber* that describes “clips” describes that “clips” can be either video or audio materials that are digitized into a media file. It is then the digitized media file that is referred to when the need arose to actually play the media associated with the clip. *See col. 1, lines 54-58.* *Reber* further describes the media archival process using such clips involves “capturing” each clip of source material for storage (col. 2, lines 17-20), where “capturing” is performed by the digitizing capturing system shown in Fig. 1. In this manner, *Reber* teaches reading content from a VTR (which may be clips) and digitizing or capturing it. There is no teaching or suggestion in *Reber* that such clips are different physical media segments from a motion picture. There is further no teaching or suggestion of physically splicing a plurality of media segments together and forming a roll by winding the spliced together media segments. Again, the clips of *Reber* are digitized (or captured) as they are read from the VTR, they are not separate pieces of media segments that are spliced together and wound into a roll. Thus, *Reber* fails to teach each and every claim limitation of independent claims 27 and 38 and their respective dependent claims.

Reber Fails to Disclose a Condensed Roll of Spliced Together Media Assets

Independent claims 27 and 38 recite that the physical volume required to store the plurality of media segments is reduced when combined and formed into the wound roll. Paragraph [0170] of the present application describes that such rolls have been found to occupy less than half (usually far less) than the traditional storage space required of such media segments when not formed in this manner.

Applicants note that there is no disclosure that *Reber reduces the physical volume of storage space* required to store the physical media assets. Digitizing clips into digitized media files as taught by *Reber* merely creates a digitized copy of the clips that may come from media sources such as VTRs. The physical volume occupied by the original hard copies of those clips on the VTRs remains the same. It is asserted in the Office Action that “it is inherent that if the VTR’s data is digitized and stored on a hard disk drive, then the segments will be reduced and it will maintain or increase the accessibility of the data via computer.” However, in order for it to be “inherent” that the physical volume of the segments will be reduced in *Reber* when the VTR’s data is digitized and stored, it would be necessary for *Reber* to destroy or discard the original content coming from the VTR and only keep the digitized content. In such case, the original content coming from the VTR would no longer be accessible. Furthermore, *Reber* does not disclose that the physical space of the content coming from the VTR is reduced in any manner.

To the contrary, independent claims 27 and 38 recite that the **physical volume** required to store the plurality of media segments is reduced when they are combined and formed into the would roll. Independent claims 27 and 38 further recites that this reduction in volume is accomplished while maintaining **accessibility to the plurality of media segments**. Again, *Reber* could only reduce the physical volume required to store its clips coming from its VTR if it discarded such clips after digitizing them, in which case it would not be maintaining accessibility to such clips. Providing accessibility to the digitized data stored on the hard disk as suggested in the Office Action is quite different than maintaining accessibility to the plurality of media segments themselves. The motion picture industry needs to access the original film media segments for certain applications and mere digital copies of such media segments simply would not suffice for those certain applications. This is in part why the motion picture industry stores

media segments themselves, and further why the present invention helps reduce their storage needs for these original media segments while providing improved access to such original media segments.

Clearly, *Reber* fails to teach or suggest reducing the physical volume required to store the plurality of media segments (i.e., film segments) while maintaining accessibility to those same plurality of media segments (i.e., film segments), as recited in independent claims 27 and 38 and their respective dependent claims. Thus, each and every limitation of claims 27-38 are not taught by *Reber* or the other cited prior art references, and it is respectfully requested that the cited prior art neither anticipates nor renders such claims obvious.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, or to credit any overpayments to Deposit Account Number **50-2638**. Please ensure that Attorney Docket Number 092807-011500 is referred to when charging any payments or credits for this case.

Date: January 7, 2008

Respectfully submitted,



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